

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/589,880
ATTORNEY DOCKET NO. Q59306

REMARKS

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority, and for indicating that the certified copy of the priority document, Japanese Patent Application No. Heisei 11-165335 dated June 11, 1999, has been made of record in the file.

Applicant thanks the Examiner for initialing the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on June 9, 2000, thereby confirming that the listed references have been considered.

Claims 1-20 have been examined on their merits.

Applicant herein cancels claim 16 without prejudice and/or disclaimer.

Applicant herein editorially amends claims 4, 6, 8, 12, 17 and 18 to remove awkward language and to correct dependencies. The amendments to claims 4, 6, 8, 12, 17 and 18 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 4, 6, 8, 12, 17 and 18 were not made for reasons of patentability.

Applicant herein amends claims 1, 9 and 15 to recite that correction information for correcting image information is received at a photographing apparatus from the image forming apparatus.

Claims 1-15 and 17-20 are all the claims presently pending in the application.

1. Claims 1-20 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Yamauchi *et al.* (U.S. Patent No. 6,020,982). The rejection of claim 16 is now moot due to its cancellation. Applicant traverses the rejection of claims 1-5 and 17-20 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Yamauchi *et al.* disclose, *inter alia*, the recordation of “intelligent data.” For example, at col. 23, lines 37-53, Yamauchi *et al.* describe the recordation of a shutter speed on a memory card as “intelligent data” and the use of the memory card to take pictures at the specified shutter speed. The Examiner claims that col. 28, lines 35-67 of Yamauchi *et al.* allegedly discloses the receipt of correction data from an image forming apparatus. However, the cited passage only discloses the setting of the diaphragm setting, focus and white balance based on whether those values are recorded in the “intelligent data” section of the memory card. Furthermore, while the

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cited passage discloses the printing of images by a reproduction unit, there is no teaching or suggestion of uploading correction information for image information from the reproduction unit. As recited in the independent claims 1, 9 and 15, Yamauchi *et al.* fail to teach or suggest that the correction information is uploaded from the image forming apparatus and the photographing apparatus performs the correction of the image information based on the uploaded correction information. Yamauchi *et al.* appear to disclose the transfer of information only from the photographing apparatus to the reproduction unit.

Based on the foregoing reasons, Applicant submits that Yamauchi *et al.* fail to disclose all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Yamauchi *et al.* clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicant submits that independent claims 1, 9 and 15 are in condition for allowance, and further believe that claims 2-8, 10-14 and 17-20 are allowable as well, at least by virtue of their dependency from claims 1, 9 and 15, respectively. Applicant respectfully requests that the Examiner withdraw the § 102(e) rejection of claims 1-15 and 17-20.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,



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